

## REMARKS/ARGUMENTS

Applicants have received the Office Action dated August 13, 2008, in which the Examiner: 1) objected to the specification; 2) rejected claims 11, 12 and 15-19 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Cui et al. (WO 03/030025 A1, hereinafter "Cui") in view of Ardoin et al. (U.S. Pat. No. 5,692,184, hereinafter "Ardoin") and Bonatti et al., *An Ontology-Extended Relational Algebra* (hereinafter "Bonatti"); and 3) rejected claims 13, 14 and 20 as being allegedly unpatentable over Cui in view of Ardoin and Bonatti and in view of W3C, *Resource Description Framework (RDF): Concepts and Abstract Syntax* (hereinafter "W3C").

With this Response, Applicants have amended claims 11 and 18. Based on the amendments and arguments contained herein, Applicants respectfully request reconsideration and allowance of the pending claims.

### I. OBJECTION TO THE SPECIFICATION

The Examiner objected to the specification as failing to provide proper antecedent basis for the claimed subject matter ("computer readable medium"). Applicants have amended paragraph [0047] to support the subject matter of original claims 18-20. The amendments to paragraph [0047] do not constitute new matter at least because claims 18-20 were part of the original disclosure.

### II. REJECTIONS UNDER 35 U.S.C. § 103(a)

#### A. Law

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.<sup>1</sup> If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.<sup>2</sup>

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

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<sup>1</sup> MPEP § 2142.

<sup>2</sup> MPEP § 2142.

combine reference teachings.<sup>3</sup> The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.<sup>4</sup> There are only three possible sources for a motivation to combine references: (1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art.<sup>5</sup> The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.<sup>6</sup> Thus, a statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references.<sup>7</sup> The teaching or suggestion to make the claimed combination must be found in the prior art, and not based on

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<sup>3</sup> MPEP § 2142.

<sup>4</sup> *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

<sup>5</sup> *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.).

<sup>6</sup> *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means can be run at a variable speed, however the court found that this does not require that the output pump be run at the claimed speed so that air is drawn into the mixing chamber and is entrained in the ingredients during operation. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.); see also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

<sup>7</sup> *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993); see also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (Court reversed obviousness rejection involving technologically simple concept because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.).

applicant's disclosure.<sup>8</sup> In addition, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.<sup>9</sup>

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must also teach or suggest all the claim limitations.<sup>10</sup>

**B. Claim 11**

Claim 11, in part, requires “generating a node to represent a functional relationship between one or more objects of distinct ontologies in a metadata system” and “associating a metadata expression of the functional relationship to the node.” The Examiner recognizes that Cui does not teach the above limitations and relies on Ardoin and Bonatti to support the obviousness rejection. See Office Action dated 08/13/08, pages 3-4, items 6 and 7. However, neither Ardoin nor Bonatti even mention metadata and thus fail to teach or suggest “associating a metadata expression of the functional relationship to the node” as in claim 11. For at least these reasons, claim 11 and its dependent claims are allowable over the cited references.

**C. Claim 18**

Claim 18 and its dependent claims are allowable for much the same reasons as given for claim 11.

**III. CONCLUSION**

In the course of the foregoing discussions, Applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may

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<sup>8</sup> MPEP § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

<sup>9</sup> MPEP § 2143.01, citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

<sup>10</sup> MPEP § 2142.

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be other distinctions between the claims and the cited art which have yet to be raised, but which may be raised in the future.

Applicants respectfully request reconsideration and that a timely Notice of Allowance be issued in this case. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,

/Alan D. Christenson/

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